

REMARKS

Upon entry of the present amendment, claims 1-4 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendment to claim 1 made herein does not incorporate new matter into the application as originally filed. In this respect, the amendment to claim 1 finds support in original Examples 1-6 (see page 25, line 22 to page 31, line 2). In each of Examples 1-6, the anticorrosive agent was added to the upper magnetic layer paint after kneading remaining components of the upper magnetic layer.

Accordingly, entry of the present amendment does not incorporate new matter into the application as originally filed.

Claim Rejections Under 35 USC § 102/103

Claim 1 has been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Aonuma US 4,253,886 (US '866). Further, claims 1-4 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Matsubaguchi et al. DE 19752953 (DE '953) [US equivalent is US 6,579,592]. Still further, claims 1-4 have been rejected under 35 USC § 103(a) as being unpatentable over Masabaguchi et al. DE '953 in view of any one of Masafumi et al. JP 05-081649 (JP '649), Yamada et al. US 4,076,890 (US '890) or Miyahara et al. US 4,369,076 (US '076). Reconsideration and withdrawal of each of these rejections is respectfully requested based upon the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

Distinctions Over the Cited Art References

Aonuma (US '886) does not disclose a magnetic recording medium of the present invention as recited in claims 1-4. Instead, Aonuma (US '886) discloses a method for preparing a corrosion-resistant ferromagnetic metal powder. However, Aonuma (US '886) does not disclose or teach a method for the production of a magnetic recording medium. Likewise it does not teach a magnetic recording medium as recited in claims 1-4.

Accordingly, it is clear that, in the invention of Aonuma US '886, an anticorrosive compound is added "immediately after the reaction producing the magnetic powders, i.e., in the

step of washing the surface of the magnetic powders” (see claim 1 and column 3, lines 21-29). Thus, Aonuma US ‘886 does not teach the addition of an anticorrosive compound after kneading the magnetic powders in a magnetic paint, which is entirely different from the invention recited in instant claim 1 (the sole independent claim under consideration).

Regarding Matsubaguchi et al. (DE ‘953), the same simply discloses a magnetic recording tape. It does not, however, teach, disclose or otherwise render obvious a magnetic recording medium as recited in pending claims 1-4, or the addition of an anticorrosive agent to a magnetic paint for a magnetic layer after kneading remaining components of the magnetic layer (as recited in instant claim 1).

Similarly, none of the references of Masafumi et al. (JP ‘649), Yamada et al. (US ‘890) or Miyahara et al. (US ‘076) disclose, teach or otherwise render obvious a magnetic recording medium as instantly claimed, or the addition of an anticorrosive agent to a magnetic paint for the magnetic layer after kneading remaining components of the magnetic layer as recited in claim 1.

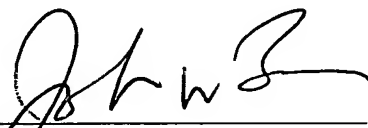
Furthermore, it is submitted that even if one of ordinary skill in the art were to consider the references of Aonuma (US ‘886), Matsubaguchi et al. (DE ‘953), Masafumi et al. (JP ‘649), Yamada et al. (US ‘890) and Miyahara et al. (US ‘076), either singularly or in combination, they in no way would be motivated to arrive at the instant invention as claimed. The failure of the references to provide such motivation to arrive at the present invention is a clear indicia of the non-obviousness of the claimed invention.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims under consideration (claims 1-4) are allowed and patentable over the cited art of record. The Examiner is respectfully requested to contact the undersigned if any questions exist with regard to the present amendment or the remarks made herein.

Dated: July 18, 2005

Respectfully submitted,

By 

John W. Bailey

Registration No.: 32,881

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant